

REMARKS

Claims 61-76, 78 and 80-88 are pending in the application.

Allowable Subject Matter

Applicants acknowledge the allowance of independent claim 61 and the indication of allowable subject matter in dependent claims 64-69, 71-76, 78 and 88.

Rejection Under 35 U.S.C. §102(a)

Claims 62, 63, 70 and 80-87 stand rejected under 35 U.S.C. § 102(a) as anticipated by WO 98/07026 (Windhab et al.).

In the Office action, the Declaration under 37 CFR 1.131 submitted with applicants' Amendment C, filed January 10, 2006, was found ineffective to overcome WO 98/07026. The Declaration was found ineffective for two reasons: (1) the Declaration was made by less than all of the inventors; and (2) the submitted evidence did not contain all of the features of the rejected claims.

Interviews

Applicants wish to thank Examiner Dwayne Handy for the personal interview conducted on July 7, 2006 with Jamie Ackley, Reg. No. 45,695, in which the undersigned attorney participated by telephone, and for the subsequent telephone interview conducted with the undersigned attorney on August 1, 2006. Applicants also wish to thank Supervisory Examiner Jill Warden for the further telephone interview conducted with the undersigned attorney on August 16, 2006.

As noted in the Interview Summary prepared by Examiner Handy, during the interview conducted July 7, 2006, the Examiner and applicants' representatives discussed the sufficiency of the

Declaration under 37 CFR 1.131. Contrary to the Interview Summary, applicants point out that the Declaration was submitted January 10, 2006 and not March 29, 2006.

In particular, applicants' representatives pointed out that it is permissible for less than all of the named inventors to make a Declaration under 37 CFR 1.131 so long as it is shown that less than all named inventors invented the subject matter of the claims under rejection (See MPEP 715.04). As stated in paragraphs 3 and 4 of his Declaration, Shenheng Guan is the sole inventor and conceived of and with the assistance of other Symyx employees reduced to practice the invention as defined in pending independent claims 61-63 and pending dependent claims 70 and 80-87 prior to February 19, 1998, the effective date of WO 98/07026. It is of no consequence that other Symyx employees assisted Shenheng Guan in reducing the claimed invention to practice. Such assistance in reducing another's conception to practice does not render the other Symyx employees inventors of the subject matter defined in claims 61-63, 70 and 80-87.

In addition, applicants' representatives discussed and reviewed in detail with Examiner Handy Exhibit A to the Declaration (an internal research report prepared by Shenheng Guan as part of his duties at Symyx Technologies, Inc.) and pointed out that the features of the invention defined in rejected claims 62, 63, 70 and 80-87 were in fact contained in Exhibit A.

At the conclusion of the July 7, 2006 interview, Examiner Handy agreed in principal with the arguments presented by applicants' representatives, but as noted in the Interview Summary, Examiner Handy wanted to discuss the arguments with Examiner Warden and would then contact applicants' representatives regarding any remaining deficiencies.

In the subsequent telephone interview conducted on August 1, 2006 with the undersigned attorney, Examiner Handy indicated that there were no longer any issues with respect to the Declaration being signed by less than all of the named inventors or that the submitted evidence did not contain all of the features of the rejected claims. However, Examiner Handy indicated that the Declaration was nevertheless deficient for failing to make a showing sufficient to establish invention of the subject matter of the rejected claims prior to the effective date of WO 98/07026. Examiner Handy advised that he would seek to clarify the remaining issues regarding the Declaration with his supervisor, Examiner Warden, and advise the undersigned attorney.

In the telephone interview conducted on August 16, 2006 with the undersigned attorney, Examiner Warden explained that the Declaration was believed to still be deficient for failing to sufficiently establish reduction to practice of the subject matter of the rejected claims prior to the effective date of WO 98/07026. In particular, Examiner Warden asserted that the statement concluding Exhibit A that "the six-channel prototype reactor is operational and producing reliable data" was mere conclusion and did not make a sufficient evidentiary showing of facts with respect to reduction to practice. Examiner Warden indicated that this deficiency could be overcome, for example, by submitting test data showing that the six-channel prototype reactor referred to in Exhibit A was operational prior to the effective date of WO 98/07026. Examiner Warden further indicated that such additional evidence in support of showing a reduction to practice of the subject matter of the rejected claims could be submitted and would be considered by the Office

without the need for filing a Request for Continued Examination (RCE).

Based on the above-noted interviews, it is applicants' understanding that the grounds for finding the Declaration under 37 CFR 1.131 ineffective as stated in the Office action mailed May 8, 2006 are no longer being maintained by the Office.

Applicants respectfully request reconsideration of the rejection of claims 62, 63, 70, and 80-87 under 35 U.S.C. §102(a) as being anticipated by WO 98/07026 (Windhab et al.) and in particular, the finding that the Declaration under 37 CFR 1.131 is ineffective to overcome WO 98/07026.

* In further support of the previously submitted Declaration of Shenheng Guan under 37 CFR 1.131, applicants enclose a second Declaration under 37 CFR §1.131 by Shenheng Guan supplemented to attest to experimental data generated using the six-channel prototype reactor referred to in Exhibit A prior to February 19, 1998, the effective date of WO 98/07026. In particular, as stated in the enclosed Declaration and supported by the accompanying Exhibits A and B, the six-channel prototype reactor apparatus of the type defined in rejected claims 62, 63 70 and 80-87 was used to analyze the performance of various molybdenum-vanadium-niobium oxide (Mo-V-Nb-O) catalysts in the catalytic gas-phase dehydrogenation of ethane to ethylene. The laboratory notebook pages 84-94 (Exhibit B) attached to the enclosed Declaration were prepared by Shenheng Guan prior to February 19, 1998 in accordance with established practices while employed at Symyx Technology, Inc. The dates on Exhibit B, like those on Exhibit A previously submitted, are prior to February 19, 1998 and have been obliterated. The data recorded in Exhibit B at least partially forms the basis for the statement made by Shenheng Guan in Exhibit A that "the six-channel prototype

reactor is operational and producing reliable data." This data evinces that the parallel fixed-bed reactor defined by currently amended independent claims 61-63 and dependent claims 70 and 80-87 was reduced to practice and worked for its intended purpose prior to February 19, 1998.

In view of the second Declaration of Shenheng Guan under 37 CFR 1.131, applicants submit that an embodiment of the rejected claims was constructed and operated for its intended purpose prior to February 19, 1998 and that WO 98/07026 is removed as a reference.

Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §102(a) and solicit allowance of all the pending claims. The Examiner is invited to contact the undersigned attorney should any issues remain unresolved.

The Commissioner is authorized to charge the fee for a two-month extension of time up to and including October 8, 2006 and any other fees in connection with this response to Deposit Account No. 19-1345.

Respectfully submitted,

A handwritten signature in black ink, reading "Vincent M. Keil". The signature is written in a cursive, flowing style.

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